

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Stephen J. Brown
Serial No.: 09/496,893
Title: SYSTEM AND METHOD FOR IDENTIFYING DISEASE-INFLUENCING
GENES
Filed: February 2, 2000
Attorney Docket No.: 00-0220 / 7553.00030
Examiner: Smith, C.
Art Unit: 1631

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal by an attorney either of record or acting under 37 CFR 1.34.

REMARKS

Review is requested for the following reasons:

1. The Office Actions dated October 27, 2008 and November 14, 2008 do not appear to have been complete as to all matters as required under 37 CFR 1.104(a)(4)(b). MPEP §2163 states:

Thus, where Office personnel establish a prima facie case of lack of written description for a claim, a thorough review of the prior art and examination on the merits for compliance with all the other statutory requirements, including those of 35 U.S.C. 101, 102, 103 and 112, is to be conducted prior to completing an Office Actions which includes a rejections for lack of written description.

MPEP §2163 further states:

Once Office personnel have concluded analysis of the claimed invention under all statutory provisions, including 35 U.S.C. 101, 112, 102 and 103, they should review all the proposed rejections and their bases to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions, and reasons which support them. When possible, the Office action should offer helpful suggestions on how to overcome rejections.

The Office Actions dated October 27, 2008 and November 14, 2008 include rejections for lack of written description. However, the Office Actions dated October 27, 2008 and November 14, 2008 do not clearly communicate whether a thorough review of the prior art and examination on the merits for compliance with all the statutory requirements, including those of 35 U.S.C. 101, 102, and 103 were conducted. As such, the Office Actions dated October 27, 2008 and November 14, 2008 do not appear to have been complete as to all matters as required under 37 CFR 1.104(a)(4)(b) or to provide all the information or references that may be useful in aiding the Applicant to judge the propriety of continuing the prosecution as required under 37 CFR 1.104(a)(2).

2. The Office Actions dated October 27, 2008 and November 14, 2008 do not provide objective evidence or authority supporting the statements and conclusions made by the Office personnel. Specifically, the Office Actions dated October 27, 2008 and November 14, 2008 provide statements regarding the meaning of certain claim language without citing the authority on which the particular definitions are based. For example, the Office Actions dated October 27, 2008 and November 14, 2008 state that “selecting” and “isolating” are two different concepts and actions (see, e.g., page 4, line 18 of the Office Action dated November 14, 2008). The Office Action provides no authority supporting this contention. In contrast, the Merriam-Webster Online Dictionary states that isolating is an inflected form of isolate, the definition of which includes “to select from among others” (see <http://www.merriam-webster.com/dictionary/isolating>). Thus, select and isolate would appear to be similar concepts and actions. As such, the definitions used by the Office appear to be overly narrow rather than reasonably broad, and the arguments made against the written description support for the claim language do not appear to be appropriately based upon objective authority.

3. The Panel Decision from Pre-Appeal Brief Review dated March 31, 2008 indicated that the panel considered there to be at least one actual issue for the Appeal Board to decide. The mere checking of a box on the Notice of Panel Decision from Pre-Appeal Brief Review did not provide adequate information under 37 C.F.R. 1.104(a)(2) to apprise the Applicant of the propriety of continuing the prosecution. Specifically, no indication of what the panel perceived the at least one actual issue to be is given. In an effort to better define what the issue was and move the prosecution of the instant application forward, Applicant filed a Request for Continued Examination along with a request for an explanation of what the issue was and why the arguments presented in the request for review had not overcome the Examiner’s rejections. The response to the Applicant’s

effort was a final Office Action that appeared to simply repeat the previously presented arguments. Even the Examiner appear to have recognized that this was an inadequate response to Applicant's reasonable request for an explanation and followed the final Office Action dated October 27, 2008 with the Supplemental Office Action dated November 14, 2008, which provided additional explanations.

However, Applicant still, after filing an RCE, finds themselves After Final. Although the Examiner points to the MPEP as supporting a Final Office Action in response to an RCE if the action could have been made final in the prior prosecution, the MPEP also states that an Applicant who is making efforts to advance the prosecution to obtain claims to which they are entitled should not be prematurely cut-off. Clearly, had the Office provided the expanded explanations, which the Examiner clearly appears to have felt were necessary as shown by the issuance of the Supplemental Office Action, in a Non-Final Office Action, Applicant would be in a position to take the Examiner's more comprehensively explained position to continue the efforts to materially advance the prosecution of the instant case.

Furthermore, since, according to the MPEP, an Office Action containing rejections based on written description should only be issued after a thorough examination under the other sections of 35 U.S.C., particularly 102 and 103, has been conducted, the fact that no rejections under sections 102 or 103 are presented in the Office Action appears to indicate that only semantic differences remain to be resolved. Clearly, an effort on the Examiner's part to work with the Applicant in resolving issues of semantics would be more beneficial than requiring that the Examiner's and Applicant's time be spent writing briefs in order to use up the time of the Appeal Board. As such, Applicant respectfully requests that the Review Panel consider that the current issues are better resolved in prosecution than on appeal.

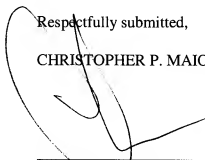
Applicant's representative believes that the Office has failed to clearly establish or provide an unambiguous indication that a thorough review of the prior art and examination on the merits for compliance with all the statutory requirements, including those of 35 U.S.C. 102, and 103, has been conducted prior to the issuing of the Office Actions which included rejections for lack of written description and therefore the Office Actions dated October 27, 2008 and November 14, 2008 are not complete. Furthermore, the finality of the Office Actions should be withdrawn in view of the extensive rebuttal arguments now put on the record by the Examiner in response to the Applicant having filed an RCE.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 50-0541.

Respectfully submitted,

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Dated: February 17, 2009

c/o Sandeep Jaggi
Health Hero Network

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